

BEST AVAILABLE COPYPatent
Attorney Docket No. 65731-76121**REMARKS**

In view of the foregoing amendments and the remarks that follow, the Examiner is respectfully requested to reconsider and withdraw the outstanding objections and rejections.

Responsive to the objection to the specification, paragraphs 19 and 26 have been amended, above. Submitted concurrently herewith is a request for permission to change the drawings which addresses the objections to Figures 11, 26 and 29. An indication of the allowability of such changes is respectfully requested.

Regarding the objection to claim 33 as being dependent from a non-elected claim, the same has been rewritten in independent form.

Claims 33-36 stand rejected under 35 U.S.C. §112, second paragraph, as vague and indefinite for use of the term N-TAD. Claim 33, from which the other claims depend, has been amended to refer to a SEQ ID NO., thus, the rejection can be removed.

Claims 40-42 stand rejected under 35 U.S.C. §112, second paragraph, as vague and indefinite for use of the term p564 spanning protein. Claim 40, from which the other claims depend, has been amended to refer to a SEQ ID NO., thus, the rejection can be removed.

Claims 40-42 stand rejected under 35 U.S.C. §112, second paragraph, as vague for reciting the term normal. The term has been revised in Claim 40, from which the other claims depend, so that the rejection can now be removed.

Claims 33-36 and 40-42 stand rejected under 35 U.S.C. §112, first paragraph, for failure to comply with the written description requirement. This rejection is respectfully traversed. The invention relates to methods of screening for agents modulating the function of N-TAD, PYI motif or p564 spanning proteins through an

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analysis of VHL activity. Specific examples of molecules in each of these groups are described in the application. Furthermore, the specific activity of interest is described. In addition to the material presented in the application, applicants are entitled to rely upon the knowledge and materials available to the skilled worker when preparing the written description. In this case, while the claimed method is novel over the state of the art, a wealth of information was available to the skilled worker regarding HIF-1 alpha and the Von Hippel-Lindau tumor suppressor protein as of the application filing date, making any additional description in the application superfluous.

Further, it is known to skilled workers that the various members of the genus may be evaluated with an agent which is known to be a modulator to ensure that each particular member of the genus will function in the claimed method. Thus, the written description, combined with the information available to and knowledge possessed by the skilled worker at the time of application filing sufficiently describes the claimed invention so that it can be practiced in its complete scope without undue experimentation. In view thereof, Applicants request that this rejection be withdrawn.

Claims 40-42 stand rejected under 35 U.S.C. §112, first paragraph, for failure to comply with the enablement requirement. It is believed that the amendments made to Claims 40-42 herein obviate the rejection. as such, removal of the rejection is respectfully requested.

Further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

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If necessary to effect a timely response, this paper should be considered as a
Petition for Extension of Time sufficient to effect a timely response, any fees may be
charged to Deposit Account No. 501249.

Respectfully Submitted,

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